

REMARKS

Claims 1-23 were present in the application as filed. By a Preliminary Amendment filed on June 4, 2004, claims 10 and 23 were amended and claims 24-60 were added.

In the Non-Final Office Action dated November 19, 2004 (“Office Action”), the Examiner requested a new Oath or Declaration, pointed out non-relevant citation in the IDS, objected to Scheme I in the specification, rejected claims 21, 22, 52, and 54 under 35 U.S.C. §112, second paragraph, and allowed claims 1-20, 23-51, 53, and 55-60.

Currently, Applicants cancel claims 21, 51, and 52 without prejudice, amend claims 22 and 54, amend Scheme I and Table 4 in the specification, and present new Oath or Declaration and new IDS. In addition, Applicants delete Table 2 from the specification.

No new matter has been added by the present amendment. The claims now pending in the application are: 1-20, 22-50, and 53-60. The Examiner’s rejections and objections are addressed below.

Oath/Declaration

The Examiner correctly pointed out that the Oath or Declaration is missing the signature of the first named inventor, Thomas P. Jerussi.

Applicants thank the Examiner for pointing out this deficiency and hereby submit a new Oath or Declaration duly signed and dated by Dr. Jerussi.

Information Disclosure Statement

The Examiner correctly pointed out that the AD entry in the previously submitted IDS lists a non-relevant patent reference, US Pat. No. 5,778,986.

Applicants thank the Examiner for pointing out this deficiency and note that the AD entry in the IDS resulted from a typographical error on the PTO-1449, which was meant to list US Pat. No. 5,788,986. Therefore, Applicants hereby submit a Supplemental IDS correctly listing US Pat. No. 5,788,986. Review of this reference is respectfully requested.

Specification

The Examiner objected to Scheme I on page 6 of the specification for showing synthesis of N-methyl analogs instead of the claimed compounds.

Applicants thank the Examiner for pointing out this inadvertent error and note that the error was made without any deceptive intent. A substitute corrected Scheme I is provided herein by an amendment to the specification. This amendment does not introduce any new matter as amended Scheme I, as well as the detailed synthesis of the claimed compounds, is described in ¶¶ 0045-0050 of the specification. A clear typographical error in the name of the reagent (R)-RSONH₂ is also corrected by this amendment.

Additionally, Applicants hereby delete Table 2 from the specification. Applicants discovered that Table 2 of the filed application accidentally presents data for another compound that was tested and reported at the same time as the claimed compounds. The Behavioral Despair Test represented in Table 2 was carried out using claimed compounds, and data from that test were available, when the original priority application was filed. Applicants will readily submit that data by declaration upon request of the Examiner. This error was an inadvertent error and was not made with any deceptive intent as evidenced by the present amendment.

Finally, Applicants draw the Examiner's attention to the fact that Table 4 has a typographical error related to a standard error of the mean ("SEM") value. Specifically, due to a typographical error, a value of "10" instead of "17" appears in the column entitled "E 10 mg/kg", in the row entitled "± sem". This error was

not made with any deceptive intent. The Applicants hereby amend Table 4 to delete the incorrect entry from this table. Applicants note that a person of skill in the art would be able to determine the missing SEM value in this column as it is calculated using a well-known mathematical formula and all the information needed to calculate the correct SEM value is available in Table 4 as amended.

Applicants believe that the Examiner's determination of patentability of the present claims does not hinge on the presently deleted data.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 21, 22, 52, and 54 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite by use of the terms "a typical antipsychotic agent" or "an atypical antipsychotic agent."

Applicants respectfully assert that the terms "typical" and "atypical" when referring to antipsychotic agents are well known in the art. *See, e.g.* Merchant *et al.*, "Differential induction of neuropeptidergic and c-fos gene expression by typical versus atypical antipsychotics," *Proc. Natl. Acad. Sci. USA*, Vol. 90, pp. 3447-3451 (1993), available at no cost via PubMed (PMCID: 46317). However, for the purposes of expediting prosecution, Applicants hereby cancel claims 21, and 52 without prejudice and amend claims 22 and 54 to remove the objected to term. Additionally, claim 51 was cancelled because it was identical to pending claim 53. No new matter has been added by this amendment. In light of the present amendment, this rejection is now moot.

Allowable Subject Matter

Applicants thank the Examiner for allowing claims 1-20, 23-51, 53, and 55-60. In light of the present amendment, Applicants respectfully request allowance of amended claims 22 and 54 as well.

Conclusion

In view of the above remarks, reconsideration and further examination is respectfully requested.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Edward Timmer, Applicants Attorney at (518) 452-5600 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Date of Deposit: May 18, 2005


EDWARD TIMMER

Respectfully submitted,



EDWARD TIMMER
Attorney for Applicant(s)
Registration No. 46,248

Dated: May 18, 2005

**HESLIN ROTHENBERG
FARLEY & MESITI, P.C.**
5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579